

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-17 are presently active in this case. The present Amendment amends Claims 1, 3, 7 and 9 and adds Claims 10-17.

In the outstanding Office Action, Claims 1-3, 5 and 7-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lisinski et al. (U.S. Patent No. 5,260,866) in view of Toyota (U.S. Patent No. 5,862,050).<sup>1</sup> Claims 1-9 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-8 of copending Application No. 10/189,260 and Claims 1-9 of copending Application No. 10/706,939.

However, Claims 4 and 6 were indicated as allowable if rewritten in independent form.

In response to the rejection under the judicially created doctrine of double patenting, Applicants herewith file a terminal disclaimer in compliance with 37 C.F.R. §1.321 thereby overcoming the double patenting rejection of Claims 1-9. For the record, Applicants note that the “filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection.”<sup>2</sup>

In order to clarify Applicants’ invention, Claims 1, 3, 7 and 9 are amended. The changes to the claims find non-limiting support in the disclosure as originally filed, for

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<sup>1</sup> The outstanding Office Action’s rejections of Claims 10-13, 15 and 17-20 at page 2 and of Claims 10-20 at page 4 are believed to be typographical errors because, prior to this amendment, the present application only included Claims 1-9.

<sup>2</sup> Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 874, 20 USPQ2d 1392, 1394-5 (Fed. Cir. 1991).

example at page 2, lines 26-30. Therefore, the changes to the claims are not believed to raise a question of new matter.<sup>3</sup>

Briefly recapitulating, Applicants' invention relates to a method to structure and manage a configuration of an industrial product, taking into account selected options. The method includes the step of describing a set of technical objects, each technical object either representing a product function or describing an implementation method for making a product configuration. The set of technical objects represents manufacturing options of the industrial product. The method further includes the step of updating the definition of each technical object and of its inter-relations with other of the technical objects in the product configuration. The definition is stored in a database and includes an expression of rules and constraints. The method further includes the step of interactively and dynamically using the database during the configuration of the product.

Turning now to the applied prior art, the Lisinski et al. patent discloses a multi-level system that generates multiple custom work orders for the manufacture of an end item and lower level configurable items comprising the end item.<sup>4</sup> The work order is a type of receipt that specifies component requirements. The Lisinski et al. patent states:<sup>5</sup>

As an example to illustrate an application of the present invention, consider the construction of a speed boat. The speed boat is the end item. Various lower-level items comprise the end item. The lower-level item may be standard part, such as the speed boat hull. Other parts, such as the engine and the radio, are configured parts because the construction of these parts depends upon the various choices or options available to the user.

However, the Lisinski et al. patent fails to teach or suggest Applicants' claimed method. In particular, and contrary to the statement of the outstanding Office Action, the

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<sup>3</sup> See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

<sup>4</sup> See the Lisinski et al. patent, e.g., the Abstract.

<sup>5</sup> See the Lisinski et al. patent, at col. 5, lines 27-34.

Lisinski et al. patent fails to teach or suggest the claimed *rules and constraints* included in the definition of a technical object and of its inter-relations with other of the technical objects.

Indeed, the rules disclosed in Lisinski et al. are not part of the definition of technical objects or of their inter-relation because they define tasks performed by the system during the course of, among other things, obtaining option values and generating custom work orders.<sup>6</sup>

Therefore, in the Lisinski et al. system, a rule is a task and not part of a definition.

In addition, and as acknowledged by the outstanding Office Action,<sup>7</sup> the Lisinski et al. patent fails to teach or suggest the claimed *set of technical objects*, each technical object either representing a product function or describing an implementation method for making a product configuration, the set of technical objects representing manufacturing options of the industrial product.

The outstanding Office Action rejects Applicants' independent Claim 1 along with dependent Claims 2-3, 5, 7-9 based on the proposition that the Toyota patent discloses the above features<sup>8</sup>, and that it would have been obvious to modify the Lisinski et al. system by incorporating these features from the Toyota system to arrive at Applicants' claimed invention. Applicants respectfully submit, however, that the Toyota patent fails to disclose the above features related to a set of technical objects, as next discussed.

The Toyota patent discloses a system for checking a production process procedure in a many-kind variable-amount production line including a plurality of production process. The outstanding Office Action relies on Toyota's Figs 1 and 3A. Figure 1 shows a process flow preparing system, which uses process code and process conditions to create a process flow in accordance with a production procedure. The system includes a data selector coupled to a variable manager for selecting the necessary information or data from the tables to

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<sup>6</sup> See the Lisinski et al. patent, at col. 7 line 66 – col. 8, line 2.

<sup>7</sup> See outstanding Office Action at page 3, lines 9-12.

<sup>8</sup> See outstanding Office Action at page 3, lines 14-23.

prepare the process flow.<sup>9</sup> Figure 3A shows a production process procedure checking system, which includes a package checker, a package condition management unit and a check decision unit. "Under the instructions from the check decision unit, while referring to the package condition management table, the package checker checks whether or not processes included in each package is normal."<sup>10</sup> Applicants respectfully point out that none of these figures discloses a set of technical objects, each technical object either representing a product function or describing an implementation method for making a product configuration, the set of technical objects representing manufacturing options of the industrial product.<sup>11</sup> Therefore, even if the combination of the Lisinski et al. and Toyota patents is assumed to be proper, the combination fails to teach every element of the claimed invention. Specifically, the combination fails to teach the claimed set of technical objects. Accordingly, Applicants respectfully traverse and request reconsideration of the rejections based on the Lisinski et al. and Toyota patents.<sup>12</sup>

In response to the rejection of Claim 2, Applicants respectfully point out that the outstanding Office Action merely states that "the industrial product is an aircraft (Abstract)". However, there is no mention of any aircraft or the like in Lisinski et al.'s Abstract. Accordingly, Claim 2 is believed to be patentably distinct over the prior art.

New Claims 10-17 are added to vary the scope of protection recited in the claims. The new claims find support in the original disclosure, for example at page 6, lines 8-13, lines 24-26 and lines 28-30 or at page 17, lines 7-11. The new claims, therefore, do not raise

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<sup>9</sup> See the Toyota patent, at col. 1, lines 32-51 with corresponding Fig. 1.

<sup>10</sup> See the Toyota patent, at col. 2, lines 23-34 with corresponding Fig. 3A.

<sup>11</sup> See the corresponding passage in the specification col. 1, lines 33-46.

<sup>12</sup> See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

a question of new matter. The combination of the Lisinski et al. and Toyota patents fails to teach or suggest the features of Claims 10-17.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-17 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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